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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,668	04/20/2005	Karl-Heinz Bauer	13908	2334

7590 03/17/2009

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EXAMINER	
WINSTON III, EDWARD B	
ART UNIT	PAPER NUMBER
4155	
MAIL DATE	DELIVERY MODE
03/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/501,668	BAUER, KARL-HEINZ	
	Examiner	Art Unit	
	EDWARD WINSTON	4155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *15 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *07/15/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the Information Disclosure Statement (IDS) filed on 15 July 2004.
2. Claim(s) 1-20 is/are currently pending and have been examined.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1-9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim(s)s 7 and 17 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

> "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.'); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').[7] A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))*

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008))* Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test.

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495).

Claim(s)s 7 is/are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claim(s)s 7 is/are non-statutory under § 101.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 2, 4-8, 13-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 the claimed "displayed on a screen" is unclear to examiner as to is the screen is the same screen or different screens. Is it the screen the patient's or specialist's computer (i.e. on the screen, displayed on a screen)
- Claim 2 is unclear to examiner as to the alternative and/or. It must be one or the other.
- Claim 4, 13 and 14, and/or must be one or the other.
- Claim 5 and 15 is unclear to examiner if data is encrypted prior to sending and decrypted upon receipt from patient to specialist or from specialist to patient.
- Claim 6 and 16 is examiner need more data for limitation.
- Claim 7 and 17 the applicant need to incorporate limitation the applicant wants to read into claim. Mixed category.

- Claim 8 and 18 is unclear to examiner as to is unclear to examiner as to the alternative and/or. It must be one or the other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail

> **Examiner's Note**: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

CLAIM 1 –

Microsoft Windows Hotmail teach(s) *a* method of securing patient data in the case of an exchange of information through a data network with the aid of computers, having the limitations of:

- entering a person's name and address (State and zip code) in a first form (Sheet 2, [Hotmail Reference. PDF]) displayed on a screen of a computer
- assigning the person an identification number (Sign-In Name) displaying the identification number on the screen (Sheet 2, [Hotmail Reference. PDF])
- entering the identification number (tedward25@hotmail.com) and a question (What is your question?) in a second form displayed on the screen (Sheet 4, [Hotmail Reference. PDF])
- assigning the answer (This is the reply to your answer!) to the question to the identification number and displaying the answer to the question on the screen when the identification number is specified (Sheet 5, [Hotmail Reference. PDF])

Microsoft Windows Hotmail does not disclose a method using an exchange of data for patients. It would have been obvious to one skilled in the art to include this means for patients to exchange information through a data network using the aid of computers with patients since email is a known quick and successful resource for communication, by using the email, patients would receive quick service from remote health care providers.

Claim 2, 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail in view of Friskel (WO 00/51394)

CLAIM 2 –

Microsoft Hotmail does not teach(s) the method of processing and storing the patient's name and address on the one hand and the question and answer on the other hand on separate Web servers and/or separate database servers. Friskel disclose(s) a method having the limitations of: the method further comprising the step of processing and storing data on separate Web servers

(figure 2 item 116-118, HTML files 120-122 figure 2) and/or separate database servers (file storage media 116-118 figure 2). (Page 7 lines 11-15, 26-27 , page 8 lines). It would have been obvious to store the patient name and address and the question and answer on the separate web server (refer to MPEP 2114.04 on obvious design choice). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Microsoft Windows Hotmail to include the a processing and storing of patient's name and address and the question and answer on separate web or database servers as taught by Friskel. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Microsoft Windows Hotmail in this way since storing data in separate web servers would provide quick access to a specific data type.

CLAIM 6–

Friskel in view of Microsoft Windows Hotmail teach(s) the method of claim 1 described above. Friskel further disclose(s) a method having the limitations of:

- wherein the answer is displayed in an invisible frameset (invisible frame) (Page 35 lines 23-28).

Friskel teach(s) a method wherein the answer is displayed in an invisible frameset. It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Microsoft Windows Hotmail to include the answer is displayed in an invisible frameset as taught by Friskel. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Microsoft Windows Hotmail in this way since framing means that a website can be organized into frames. Each frame displays a different HTML document. Headers and sidebar menus do not move when the content frame is scrolled up and down. For developers frames are convenient.

CLAIM 16–

Refer to Claim 6

Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail in view of Walker et al. (US 7,454,776)

CLAIM 4–

Walker et al. in view of Microsoft Windows Hotmail teach(s) the method of claim 1 described above. Walker et al. further disclose(s) a method having the limitations of:

- the steps of saving the patient's name and address filed on a Web server and/or database server to an external data medium (different storage device lines 26-27) at the end of a stipulated (predetermined line 27) period of time and deleting the patient's name and address from the Web server and/or database server (Column 7 lines 25-27)

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the device of Microsoft Windows Hotmail to include saving the patient's name and address filed on a Web server and/or database server to an external data medium at the end of a stipulated period of time and deleting the patient's name and address from the Web server and/or database server as taught by Walker et al. One of ordinary skill in the art at the time of the invention would have been motivated to expand the device of Microsoft Windows Hotmail in this way to conserve storage space on the data storage device (Column 7 lines 25-26).

Claim 3, 12, 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail in view of Friskel (WO 00/51394), and further in view of Walker et al. (US 7,454,776)

CLAIM 3 –

Walker et al. further disclose(s) a method having the limitations of:

- the step of deleting the identification number (program identification number field, column 7 lines 17-18) at the end of a stipulated (predetermined, column 7 line 27) period

of time (Column 7 lines 17-19 [program identification number field], lines 25-27 [deleted after some predetermined time interval])

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the device of Microsoft Windows Hotmail to include a method of deleting the identification number at the end of a stipulated period of time as taught by Walker et al. One of ordinary skill in the art at the time of the invention would have been motivated to expand the device of Microsoft Windows Hotmail in this way to conserve storage space on the data storage device (Column 7 lines 25-26)

CLAIM 12–

Refer to Claim 3

CLAIM 13–

Refer to Claim 4

CLAIM 14–

Refer to Claim 4

Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail in view of Ofir (US 2003/0007645)

CLAIM 5–

Ofir teach(s) method further comprising the steps of, encrypting the data prior to sending and decrypting the data upon receipt (see at least Page 3 paragraph 31 lines 4-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Microsoft Windows Hotmail to include encrypting the data prior to sending and decrypting the data upon receipt as taught by Ofir. One of ordinary skill in the art at the time of the invention

would have been motivated to expand the method of Microsoft Windows Hotmail in this way since instead of a plurality of remote users communicating via a centralized computer, they now communicated via distributed computers all connected to a common network. The resulting flow of data through the network has effectively rendered all data publicly accessible since it is susceptible to interception en route and, in order to restore privacy, it has become necessary to encrypt the data so that only authorized users are able to make sense of it (Page 1 paragraph [0004]).

Claim 7, 8, 9, 17, 18, 19 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel (WO 00/51394) in view of Microsoft Windows Hotmail

CLAIM 7–

Friskel teach(s) a device for securing patient data in the case of an exchange of information between a patient and a specialist by means of a data network, in particular for performing the method of claim 1, :

- comprising a first Web server (figure 2 items 106-114 and 116) and a database server connected to the first Web server (figure 2 items 126)
- the second Web server (figure 2 items 106-114 and 118) is connected to the database server (figure 2 items 126)
- the first Web server and the second Web server are isolated from each other (figure 2 items 106-114 and 116-118)

Friskel does not teach a method through which the patient's name and address are entered and saved, through which the patient is assigned an identification number, and the patient is able to exchange data with a specialist under his identification number. It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Friskel to include the method through which the patient's name and address are entered and saved (Sheet 2,

[Hotmail Reference. PDF]), through which the patient is assigned an identification number (Sheet 2, [Hotmail Reference. PDF]), and the patient is able to exchange data with a specialist under his identification number (page 2-3) as taught by Microsoft Windows Hotmail. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Microsoft Windows Hotmail in this way for security reasons since the single login ID or sign-in name has an associated user profile that contains the registration information typically requested by web servers during a user registration process. The login ID allows the web site to identify the user and retrieve the user's information during subsequent user visits to the web site. Generally, the login ID must be unique to the web site such that no two users have the same login ID therefore allowing a user (i.e. patient) to exchange data with a specialist after his/her identification is specified.

CLAIM 17–

Refer to Claim 7

CLAIM 18–

Refer to Claim 8

CLAIM 19–

Refer to Claim 9

CLAIM 20–

Refer to Claim 9

CLAIM 8–

Friskel further disclose(s) a device of claim 8:

- wherein physical separation is provided between the first Web server (Figure 2 items 106-114 and 116) and the database server (Figure 2 item 126) on the one hand, and

between the second Web server (Figure 2 items 106-114 and 118) and the database server (Figure 2 item 126) on the other hand.

CLAIM 9–

Friskel further disclose(s) a device of claim 9:

- further comprising a second database server (figure 2 item 102) said second database server is connected to the first and/or the second Web server (see at least Page 7 lines 11-15 and Figure 2 items numbered 106-114 and items numbered 116-122 of Friskel)

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel (WO 00/51394) in view of Microsoft Windows Hotmail and further in view of Walker (US 7,454,776).

CLAIM 10–

Walker et al. further discloses a method further comprising a backup unit, which saves the data from the database server to an external data medium at regular intervals of time and deletes the data from the database server. (Column 7, lines 25-27)

Walker et al. teach(s) method comprising a backup unit, which saves the data from the database server to an external data medium at regular intervals of time and deletes the data from the database server (column 7 Lines 25-27). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the device of Friskel to include a backup unit, which saves the data from the database server to an external data medium at regular intervals of time and deletes the data from the database server as taught by Walker et al. One of ordinary skill in the art at the time of the invention would have been motivated to expand the device of Friskel in this way to conserve storage space on the data storage device (Column 7 lines 25-26).

Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel (WO 00/51394) in view of Microsoft Windows Hotmail and further in view of Ofir (US 2003/0007645)

CLAIM 11–

Ofir further discloses a method:

Ofir teach(s) method further comprising a crypto module for the purpose of encrypting and decrypting the data (Paragraph [0039] lines 4-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Friskel to include a crypto module (software modules) for the purpose of encrypting and decrypting the data taught by Ofir. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Friskel in this way since flow of data through the network has effectively rendered all data publicly accessible since it is susceptible to interception en route and, in order to restore privacy, it has become necessary to encrypt the data so that only authorized users are able to make sense of it (Page 1 paragraph [0004]).

Claim 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Windows Hotmail in view of Friskel (WO 00/51394 and further in view of Ofir (US 2003/0007645)

CLAIM 15–

Refer to Claim 5

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD WINSTON whose telephone number is (571)270-7780. The examiner can normally be reached on MONDAY-THURDAY; 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THU NGUYEN can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EBW
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/THU NGUYEN/
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